



PATENT
Customer No. 22,852
Attorney Docket No. 05725.0800-00000

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:)
Roland BAZIN et al.)
Application No.: 09/725,048) Group Art Unit: 3743
Filed: November 29, 2000) Examiner: Annette F. Dixon
For: PROCESS FOR ACQUIRING SCANNED) Confirmation No.: 8605
IMAGE DATA RELATING TO AN)
EXTERNAL BODY PORTION AND/OR A)
PRODUCT APPLIED THERETO)

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Sir:

APPEAL BRIEF UNDER 37 C.F.R. § 41.37

This is an appeal to the Board of Patent Appeals and Interferences ("the Board") from the final Office Action dated October 13, 2006 ("final Office Action"), finally rejecting claims 4, 6-8, 11, 25-48, 59, 61, and 62, in the above-referenced patent application. In accordance with M.P.E.P. § 1204.1, the prior Appeal Brief fee payment of \$500.00 filed on June 20, 2005, should be applied to this Appeal Brief.

A Notice of Appeal was filed on February 1, 2007. A petition for a one-month extension of time and fee payment are filed concurrently herewith to extend the period for filing the Appeal Brief to May 1, 2007.

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TABLE OF CONTENTS

	<u>Page No.</u>
I. Real Party in Interest.....	1
II. Related Appeals and Interferences	2
III. Status of Claims	3
IV. Status of Amendments.....	4
V. Summary of Claimed Subject Matter.....	5
A. Independent Claim 4	5
B. Independent Claim 11	6
C. Independent Claim 25	6
D. Independent Claim 37	7
E. Independent Claim 38	8
F. Independent Claim 46	9
G. Independent Claim 48	10
H. Independent Claim 59	11
VI. Grounds of Rejection to be Reviewed on Appeal.....	12
VII. Argument	13
A. The rejection of claims 4, 6, 37, 46-48, 59, 61, and 62 under 35 U.S.C. § 102(b) based on Groh should be reversed because Groh fails to disclose all of the features recited in the claims	13
1. Groh does not disclose placing a transfer member in contact with an external body portion including a cosmetic applied thereto, as recited in claim 4.....	13
2. Groh does not disclose image data for an image representative of at least one characteristic of a cosmetic product, as recited in claim 4	14
3. Groh does not disclose foundation makeup, as recited in claim 6	15
4. Groh does not disclose comparing a displayed image to one or more images formed from image data stored in an image database, as recited in claim 37	15

5.	Groh does not disclose displaying an image formed from scanned image data and viewing the displayed image to analyze one or more characteristics of an external body portion and/or product(s), as recited in claim 46.....	16
6.	Groh does not disclose placing a transfer member in contact with an external body portion including a cosmetic applied thereto, and image data for an image representative of at least one characteristic of the cosmetic product, as recited in claim 47	17
7.	Groh does not disclose an image scanner configured in the form of a scanner for scanning documents, as recited in claim 48	17
8.	Groh does not disclose analysis equipment chosen from one of a corneometer, a dermal torque meter, a PH meter, and a device for measuring hydration of the skin, as recited in claim 59	18
B.	The rejection of claims 4, 7, 8, and 11 under 35 U.S.C. § 102(e) based on Stess should be reversed because Stess fails to disclose all of the features recited in the claims	18
1.	Stess does not disclose a transfer member placed in direct contact with an external body portion including a cosmetic product applied thereto, as recited in independent claim 4.....	18
2.	Stess does not disclose scanning with an optical image scanner to obtain scanned image data for an image, as recited in independent claim 4	20
3.	Stess does not disclose foundation makeup, as recited in claim 6, from which claims 7 and 8 depend	20
4.	Stess does not disclose placing moldable material of a transfer member in direct contact with the skin of an individual to produce, on the moldable material, the surface profile of the skin, as recited claim 11.....	21
5.	Stess does not disclose scanning with an optical image scanner to obtain scanned image data for an image, as recited claim 11.....	22
C.	The Section 103(a) rejection of claims 25-36 and 38-45 should be reversed because the Examiner has failed to set forth a <i>prima facie</i> case of obviousness	22
1.	Neither Groh nor Kvedar, nor any combination thereof, discloses or suggests scanning with an optical image scanner to obtain scanned image data for an image, as recited claims 25 and 38.....	22

2.	There is no motivation, teaching, or suggestion to combine Groh and Kvedar as proposed by the Examiner.....	23
D.	Conclusion.....	23
VIII.	Claims Appendix	25
IX.	Evidence Appendix	37
X.	Related Proceedings Appendix.....	38



I. Real Party in Interest

The real party in interest is L'Oréal S.A., the assignee of the entire right, title, and interest in the application.

II. Related Appeals and Interferences

In U.S. Application No. 09/725,049 (attorney docket No. 05725.0784-00000), which is now abandoned, an Appeal Brief was filed on August 15, 2005, and the Examiner subsequently re-opened prosecution prior to any decision by the Board. The Appeal Brief filed in U.S. Application No. 09/725,049 may be related to, directly affect, or have a bearing on the Board's decision in the pending appeal. Appellant, Appellant's legal representatives, and assignee are aware of no other appeals, interferences, or judicial proceedings that may be related to, directly affect, be directly affected by, or have a bearing on the Board's decision in this appeal.

III. Status of Claims

Claims 4-20, 24-48, 59, 61, and 62 are pending in this application, and claims 1-3, 21-23, 49-58, 60, and 63 remain canceled. Claims 5, 9, 10, 12-20, and 24 have been withdrawn by the Examiner.¹ Claims 4, 6-8, 11, 25-48, 59, 61, and 62, as set forth in the Claims Appendix, have been finally rejected in the final Office Action and the rejections applied to those claims are at issue in this appeal.

¹ The final Office Action contains a number of statements relating to a prior election of species requirement that led to claims 5, 9, 10, 12-20, and 24 being withdrawn. Appellants do not necessarily agree with any of those statements and note that the final Office Action at pages 3-5 contains erroneous allegations regarding issues such as disclosure, enablement, and support.

IV. Status of Amendments

No amendments have been filed subsequent to the final Office Action.

V. Summary of Claimed Subject Matter

A. Independent Claim 4

The subject matter set forth in independent claim 4 relates to a process for acquiring scanned image data relating to an external body portion and/or a product applied to the external body portion. Page 4, lines 3-5.² The process comprises placing a transfer member in contact with an external portion of an individual so as to obtain a transfer image on the transfer member. Page 4, lines 5-6; Figs. 3, 4, and 7. The transfer image is present on the transfer member after the transfer member and the external portion are out of contact with one another. Page 5, lines 1-14; Fig. 4. The transfer image is not a fingerprint or fingerprints, and the external portion that the transfer member is placed in contact with does not include a tooth or teeth. Page 4, lines 10-17; page 8, lines 1-10; Figs. 3, 4, and 7. The process further comprises scanning the transfer image with an optical image scanner to obtain scanned image data for an image representative of at least one characteristic of the external body portion, and/or at least one product applied to the external body portion. Page 4, lines 7-9; Figs. 5-7. In the process of claim 4, the transfer member is placed in direct contact with an external body portion including a cosmetic product applied thereto, and the image of the scanned image data is representative of at least one characteristic of the cosmetic product. Page 5, line 10 - page 6, line 4; page 17, line 19 - page 18, line 19; Fig. 7.

² The references to the specification and drawings in this Brief are merely intended to facilitate explaining how the originally-filed application provides exemplary disclosure relating to the claimed subject matter. Those references are not necessarily exhaustive. Furthermore, those references should not be construed as limiting the claims.

B. Independent Claim 11

The subject matter set forth in independent claim 11 relates to a process for acquiring scanned image data relating to an external body portion and/or a product applied to the external body portion. Page 4, lines 3-5. The process comprises placing a transfer member in contact with an external portion of an individual so as to obtain a transfer image on the transfer member. Page 4, lines 5-6; Figs. 3, 4, and 7. The transfer image is present on the transfer member after the transfer member and the external portion are out of contact with one another. Page 5, lines 1-14; Fig. 4. The transfer image is not a fingerprint or fingerprints, and the external portion that the transfer member is placed in contact with does not include a tooth or teeth. Page 4, lines 10-17; page 8, lines 1-10; Figs. 3, 4, and 7. The process further comprises scanning the transfer image with an optical image scanner to obtain scanned image data for an image representative of at least one characteristic of the external body portion, and/or at least one product applied to the external body portion. Page 4, lines 7-9; Figs. 5-7. In the process of claim 11, the transfer member is a moldable material, and the process includes placing the moldable material in direct contact with the skin of the individual to produce, on the moldable material, the surface profile of the skin. Page 6, lines 5-7; page 18, line 20 - page 19, line 2.

C. Independent Claim 25

The subject matter set forth in claim 25 relates to a process for acquiring scanned image data relating to an external body portion and/or a product applied to the external body portion. Page 4, lines 3-5. The process comprises placing a transfer member in contact with an external portion of an individual so as to obtain a transfer

image on the transfer member. Page 4, lines 5-6; Figs. 3, 4, and 7. The transfer image is present on the transfer member after the transfer member and the external portion are out of contact with one another. Page 5, lines 1-14; Fig. 4. The transfer image is not a fingerprint or fingerprints, and the external portion that the transfer member is placed in contact with does not include a tooth or teeth. Page 4, lines 10-17; page 8, lines 1-10; Figs. 3, 4, and 7. The process further comprises scanning the transfer image with an optical image scanner to obtain scanned image data for an image representative of at least one characteristic of the external body portion, and/or at least one product applied to the external body portion. Page 4, lines 7-9; Figs. 5-7. In the process of claim 25, the image scanner is associated with a first computer located at a first location, and the process further comprises transferring the scanned image data from the first computer to a second computer located at a second location remote from the first location. Page 7, lines 8-13; Fig. 1. In addition, the image scanner is configured in the form of a scanner for scanning documents. Page 14, lines 19-21; Fig. 5.

D. Independent Claim 37

The subject matter set forth in claim 37 relates to a process of analyzing at least one characteristic of an external body portion of an individual and/or at least one product applied to the external body portion. Page 7, lines 18-19. The process comprises acquiring scanned image data. The acquiring comprises placing a transfer member in contact with an external portion of an individual so as to obtain a transfer image on the transfer member (page 4, lines 5-6; Figs. 3, 4, and 7), wherein the transfer image is present on the transfer member after the transfer member and the external

portion are out of contact with one another (page 5, lines 1-14; Fig. 4), and wherein the transfer image is not a fingerprint or fingerprints, and the external portion that the transfer member is placed in contact with does not include a tooth or teeth (page 4, lines 10-17; page 8, lines 1-10; Figs. 3, 4, and 7); and scanning the transfer image with an optical image scanner to obtain scanned image data for an image representative of at least one characteristic of the external body portion, and/or at least one product applied to the external body portion (page 4, lines 7-9; Figs. 5-7). The process of claim 37 further includes displaying an image corresponding to the scanned image data, viewing the displayed image to analyze the at least one characteristic, and comparing the displayed image to at least one image formed from image data stored in an image database. Page 7, lines 19-21; page 10, lines 4-6.

E. Independent Claim 38

The subject matter set forth in claim 38 relates to a process for recommending treatment for an external body portion. Page 9, lines 6-7. The process comprises analyzing at least one characteristic of an external body portion, wherein the analyzing comprises acquiring scanned image data, displaying an image corresponding to the scanned image data, and viewing the displayed image to analyze the at least one characteristic. Page 7, lines 19-21. The acquiring comprises placing a transfer member in contact with an external portion of an individual so as to obtain a transfer image on the transfer member (page 4, lines 5-6; Figs. 3, 4, and 7), wherein the transfer image is present on the transfer member after the transfer member and the external portion are out of contact with one another (page 5, lines 1-14; Fig. 4), and wherein the transfer image is not a fingerprint or fingerprints, and the external portion that the

transfer member is placed in contact with does not include a tooth or teeth (page 4, lines 10-17; page 8, lines 1-10; Figs. 3, 4, and 7); and scanning the transfer image with an optical image scanner to obtain scanned image data for an image representative of at least one characteristic of the external body portion, and/or at least one product applied to the external body portion (page 4, lines 7-9; Figs. 5-7). The process of claim 38 further comprises determining a recommendation of at least one treatment for the external portion, and providing the treatment recommendation so that the external portion of the individual may be treated according to the recommendation. Page 9, lines 6-19. In addition, claim 38 recites that the image scanner is configured in the form of a scanner for scanning documents. Page 14, lines 19-21.

F. Independent Claim 46

The subject matter set forth in claim 46 relates to a process of evaluating a product applied to an external body portion. Page 9, lines 20-22. The process comprises analyzing at least one characteristic of a product applied to an external body portion. Page 8, lines 11-19. The analyzing comprises acquiring scanned image data, displaying an image corresponding to the scanned image data, and viewing the displayed image to analyze at least one characteristic. Page 7, lines 18-21. Acquiring scanned image data comprises placing a transfer member in contact with an external portion of an individual so as to obtain a transfer image on the transfer member. Page 4, lines 5-6; Figs. 3, 4, and 7. The transfer image is present on the transfer member after the transfer member and the external portion are out of contact with one another. Page 5, lines 1-14; Fig. 4. The transfer image is not a fingerprint or fingerprints, and the external portion that the transfer member is placed in contact with

does not include a tooth or teeth. Page 4, lines 10-17; page 8, lines 1-10; Figs. 3, 4, and 7. Acquiring scanned image date further comprises scanning the transfer image with an optical image scanner to obtain scanned image data for an image representative of at least one characteristic of the external body portion, and/or at least one product applied to the external body portion. Page 4, lines 7-9; Figs. 5-7.

G. Independent Claim 48

The subject matter set forth in claim 48 relates to a process for acquiring scanned image data relating to an external body portion and/or a product applied to the external body portion. Page 4, lines 3-5. The process comprises placing a transfer member in contact with an external portion of an individual so as to obtain a transfer image on the transfer member. Page 4, lines 5-6; Figs. 3, 4, and 7. The transfer image is present on the transfer member after the transfer member and the external portion are out of contact with one another. Page 5, lines 1-14; Fig. 4. The transfer image is not a fingerprint or fingerprints, and the external portion that the transfer member is placed in contact with does not include a tooth or teeth. Page 4, lines 10-17; page 8, lines 1-10; Figs. 3, 4, and 7. The process further comprises scanning the transfer image with an optical image scanner to obtain scanned image data for an image representative of at least one characteristic of the external body portion, and/or at least one product applied to the external body portion. Page 4, lines 7-9; Figs. 5-7. As set forth in claim 48, the process further comprises collecting information relating to the transfer image of the transfer member to form a database for use in at least one of diagnoses, treatment recommendation determinations, product evaluations, and product formulations. Page 10, lines 1-4.

H. Independent Claim 59

The subject matter set forth in claim 59 relates to a process for acquiring scanned image data relating to an external body portion and/or a product applied to the external body portion. Page 4, lines 3-5. The process comprises placing a transfer member in contact with an external portion of an individual so as to obtain a transfer image on the transfer member. Page 4, lines 5-6; Figs. 3, 4, and 7. The transfer image is present on the transfer member after the transfer member and the external portion are out of contact with one another. Page 5, lines 1-14; Fig. 4. The transfer image is not a fingerprint or fingerprints, and the external portion that the transfer member is placed in contact with does not include a tooth or teeth. Page 4, lines 10-17; page 8, lines 1-10; Figs. 3, 4, and 7. The process further comprises scanning the transfer image with an optical image scanner to obtain scanned image data for an image representative of at least one characteristic of the external body portion, and/or at least one product applied to the external body portion. Page 4, lines 7-9; Figs. 5-7. As set forth in claim 59, the process further comprises analyzing the external body portion and/or the transfer member with analysis equipment chosen from one of a corneometer, a dermal torque meter, a pH meter, and a device for measuring hydration of the skin. Page 25, lines 5-9.

VI. Grounds of Rejection to be Reviewed on Appeal

Claims 4, 6, 37, 46-48, 59, 61, and 62 stand rejected under 35 U.S.C. § 102(b) based on U.S. Patent No. 5,343,536 to Groh ("Groh").

Claim 4, 7, 8, and 11 stand rejected under 35 U.S.C. 102(e) based on U.S. Patent No. 6,533,971 to Stess et al. ("Stess").

Claims 25-36 and 38-45 stand rejected under 35 U.S.C. § 103(a) based on Groh in view of Kvedar et al., "Teledermatology in a Capitated Delivery System Using Distributed Information Architecture: Design and Development" ("Kvedar").

VII. Argument

A. The rejection of claims 4, 6, 37, 46-48, 59, 61, and 62 under 35 U.S.C. § 102(b) based on Groh should be reversed because Groh fails to disclose all of the features recited in the claims

1. Groh does not disclose placing a transfer member in contact with an external body portion including a cosmetic applied thereto, as recited in claim 4

Appellants respectfully submit that the Section 102(b) rejection of independent claim 4 and dependent claim 6 should be reversed because Groh does not disclose “placing a transfer member in contact with an external body portion . . . including a cosmetic product applied thereto,” as recited in claim 4. In the final Office Action at pages 5-6, the Examiner apparently equates a microscopic slide 11 of Groh with the recited transfer member, and the Examiner alleges that “the [purported] transfer member is placed in contact with an external body portion that is *inherently capable* of including a cosmetic product applied thereto.” (Emphasis supplied). Contrary to the Examiner’s allegation, however, Groh does not disclose placing a transfer member in contact with an external body portion having a cosmetic product applied thereto and, thus, nothing in Groh supports the Examiner’s inherency allegation. Moreover, the rejection is flawed even further because it does not satisfy the requirements for a proper inherency-based rejection, as dictated by legal precedent.

“To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’”

M.P.E.P. § 2112(IV) (quoting In re Robertson, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999)).

The Examiner has failed to satisfy the burden of establishing inherency because Groh does not necessarily disclose a “transfer member [that] is placed in direct contact with an external body portion including a cosmetic product applied thereto,” as recited in independent claim 4. Indeed, the Examiner has merely alleged that a purported external body portion of Groh would be “*capable*” of including a cosmetic product applied thereto. Final Office Action at p. 6. Such a mere allegation of capability clearly fails to satisfy the Examiner’s evidentiary burden required for the inherency-based claim rejection. See, e.g., M.P.E.P. § 2112(IV) (“The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.” (emphasis in original).) Accordingly, independent claim 4 and claim 6, which depends therefrom, are patentably distinguishable from Groh.

2. Groh does not disclose image data for an image representative of at least one characteristic of a cosmetic product, as recited in claim 4

The Section 102(b) rejection of claims 4 and 6 also should be reversed because Groh does not disclose “scanning . . . to obtain scanned image data for an image . . . representative of at least one characteristic of the cosmetic product [applied to the external body portion],” as recited in claim 4. With respect to this claim recitation, the Examiner merely alleges that “[a]ny facial cosmetic worn by the patient (i.e., moisturizer, foundation makeup, etc) would *inherently* be captured with the comedones when the transfer member is placed in contact with the external portion, and such cosmetic would be part of the scanned image data.” Final Office Action at p. 6 (emphasis supplied). Here again, nothing supports the Examiner’s inherency allegation or the inherency-based rejection.

Appellants respectfully submit that the Examiner has failed again to satisfy the burden of establishing inherency because Groh does not necessarily disclose “scanning . . . to obtain scanned image data for an image . . . representative of at least one characteristic of the cosmetic product [applied to the external body portion],” as recited in independent claim 4. As mentioned above, Groh does not disclose a cosmetic product applied to the external body portion. Further, Groh does not disclose the recited “image of the scanned image data [being] representative of at least one characteristic of the cosmetic product,” as recited in claim 4. Thus, independent claim 4 and dependent claim 6 are patentable over Groh for this additional reason.

3. Groh does not disclose foundation makeup, as recited in claim 6

The Section 102(b) rejection of claim 6 also should be reversed because Groh fails to disclose “foundation makeup,” as recited in claim 6. Contrary to the Examiner’s inherency allegations in the final Office Action at page 6, Groh does not necessarily disclose “foundation makeup.” For example, Groh fails to even mention the terms “foundation” or “makeup.” Consequently, claim 6 is allowable over Groh for these additional reasons.

4. Groh does not disclose comparing a displayed image to one or more images formed from image data stored in an image database, as recited in claim 37

The Section 102(b) rejection of claim 37 should be reversed because Groh does not disclose “comparing [a] displayed image to at least one image formed from image data stored in an image database,” as recited in claim 37. In the final Office Action at pages 6-7, the Examiner cites Groh at col. 3, lines 1-32 and alleges that “[an] image can

be compared to at least one other image formed from image data stored in and retrievable from an image database" Contrary to the Examiner's allegation, Groh lacks any disclosure of comparing a displayed image to one or more other images formed from image data stored in an image database. For example, no such comparing is described in Groh at col. 3, lines 1-32, and Groh does not refer to any capability of conducting such comparing. Rather than having any disclosure of a displayed image being compared to one or more other images formed from image data stored in an image database, Groh merely describes using an image analysis system that evaluates an image to generate data such as size, shape, and total number count of comedones appearing in specimen images. See col. 5, lines 55-60. For at least these reasons, independent claim 37 is patentably distinguishable from Groh.

5. **Groh does not disclose displaying an image formed from scanned image data and viewing the displayed image to analyze one or more characteristics of an external body portion and/or product(s), as recited in claim 46**

The Section 102(b) rejection of independent claim 46 and dependent claim 47 should be reversed because Groh does not disclose "displaying an image formed from . . . scanned image data; and viewing the displayed image to analyze . . . at least one characteristic [of an external body portion and/or at least one product]," as recited in claim 46. Rather than having any disclosure of such features, Groh describes examining a specimen under a microscope and evaluating the specimen using image analysis hardware and software to determine the number of comedones existing in the specimen. See Abstract. Examining a specimen with a microscope and evaluating the specimen with image analysis hardware and software is not the same as, and does not

result in “displaying an image formed from . . . scanned image data; and viewing the displayed image . . . ,” as recited in independent claim 46. Therefore, independent claim 46 and claim 47, which depends therefrom, are patentably distinguishable from Groh.

6. **Groh does not disclose placing a transfer member in contact with an external body portion including a cosmetic applied thereto, and image data for an image representative of at least one characteristic of the cosmetic product, as recited in claim 47**

Similar to claim 4, claim 47 recites that a “transfer member is placed in contact with an external body portion including a cosmetic product applied thereto, and [that] the scanned image data is representative of at least one characteristic of the cosmetic product.” Consequently, the Section 102(b) rejection of claim 47 also should be reversed for all of the reasons discussed above in Sections VII.A.1 and VII.A.2. for claim 4.

7. **Groh does not disclose an image scanner configured in the form of a scanner for scanning documents, as recited in claim 48**

The Section 102(b) rejection of independent claim 48 and dependent claims 61 and 62 should be reversed because Groh does not disclose an “image scanner . . . configured in the form of a scanner for scanning documents,” as recited in claim 48. One of ordinary skill in the art would understand that Groh’s general description of a digital image analysis apparatus does not disclose a scanner having a document scanning configuration.

Contrary to the Examiner’s allegation in the final Office Action at page 2, nothing supports “an image . . . be[ing] interpreted as a document.” Furthermore, such an

unsupported and strained interpretation of the term “image” fails to provide any meaningful explanation of why claim 48 has been rejected.

For at least these reasons, independent claim 48 and claims 61 and 62, which depend therefrom, should be allowable over Groh.

8. **Groh does not disclose analysis equipment chosen from one of a corneometer, a dermal torque meter, a PH meter, and a device for measuring hydration of the skin, as recited in claim 59**

The Section 102(b) rejection of claim 59 should be reversed because Groh does not disclose analysis equipment “chosen from one of a corneometer, a dermal torque meter, a PH meter, and a device for measuring hydration of the skin,” as recited in claim 59. Rather than providing any meaningful explanation of why claim 59 was rejected, the Examiner merely alleges that “Applicant’s specification as originally filed asserts each recited analysis equipment is equivalent as there is no criticality recited between elements.” Final Office Action at p. 2. Appellants disagree. To the extent the Examiner’s allegation is understood, it appears to reflect that the Examiner is improperly using the disclosure of the present application as a reference to reject the claim. For at least this reason, independent claim 59 is patentably distinguishable from Groh.

- B. **The rejection of claims 4, 7, 8, and 11 under 35 U.S.C. § 102(e) based on Stess should be reversed because Stess fails to disclose all of the features recited in the claims**

1. **Stess does not disclose a transfer member placed in direct contact with an external body portion including a cosmetic product applied thereto, as recited in independent claim 4**

The Section 102(e) rejection of independent claim 4 and dependent claims 7 and 8 should be reversed because Stess does not disclose a transfer member “placed

in direct contact with an external body portion including a cosmetic product applied thereto," as recited in independent claim 4. Appellants do not understand the basis for the Section 102(e) rejection of claim 4. On page 8 of the final Office Action, the Examiner cites reference numerals "25/27" as allegedly corresponding to a transfer member, and the Examiner acknowledges that "the [purported] transfer member is not placed into direct contact with the skin." (Emphasis in original.) Assuming the Examiner has equated skin with the external portion recited in claim 4, the Examiner's statement appears to acknowledge that Stess does not disclose placing a transfer member in direct contact with skin or any other external body portion.

On page 2 of the final Office Action, the Examiner alleges that the recitation of "direct" in claim 4 purportedly "does not read over the prior art as the transfer member is fully capable of being placed in direct contact with the product applied to the external body portion . . ." Further, in the final Office Action at page 7, the Examiner alleges that Stess purportedly discloses a transfer member placed in contact with an external body portion "that is inherently capable of including a cosmetic product applied thereto . . ." Appellants submit that the final Office Action does not set forth a legally proper basis for these allegations of alleged capability and inherency. Speculation about the purported, possible capability of subject matter in a reference does not provide any evidence of inherent disclosure or any other basis for rejecting claims in an anticipation rejection. See M.P.E.P. § 2112(IV).

For at least these reasons, claims 4, 7, and 8 are patentable over Stess.

2. Stess does not disclose scanning with an optical image scanner to obtain scanned image data for an image, as recited in independent claim 4

The Section 102(e) rejection of claims 4, 7, and 8 also should be reversed because Stess does not disclose “scanning . . . with an optical image scanner to obtain scanned image data for an image,” as recited in claim 4. Based on the Examiner’s comments, the Examiner seems to be equating Stess’s general disclosure of a digital scanner 51 with an “optical image scanner.” Stess merely discloses using a digital scanner to obtain “digital data” relating to the dimensions of an impression shirt. Col. 6, lines 10-31. There is nothing in Stess providing any express or inherent teaching of the recited “scanning . . . with an optical image scanner to obtain scanned image data for an image.” Stess never mentions or suggests an “optical image” or “scanned image data for an image.” Indeed, Stess’s digital scanner is not described as being an “optical image scanner.” Furthermore, there are many digital scanners that are not optical image scanners (i.e., some scanners use technology without any optical imaging). Moreover, since the purpose of Stess’s disclosed digital scanner 51 relates to proper dimensioning of an orthosis, one of ordinary skill in the art would understand that Stess’s scanner 51 would merely obtain dimensions of the impression shirt rather than obtaining any “image data” for an “image.” For at least these reasons, the rejection of claims 4, 7, and 8 should be reversed.

3. Stess does not disclose foundation makeup, as recited in claim 6, from which claims 7 and 8 depend

The rejection of claims 7 and 8 should also be reversed because Stess does not disclose “foundation makeup,” as recited in claim 6, from which claims 7 and 8 depend.

4. **Stess does not disclose placing moldable material of a transfer member in direct contact with the skin of an individual to produce, on the moldable material, the surface profile of the skin, as recited claim 11**

The Section 102(e) rejection of claim 11 should be reversed because Stess does not disclose placing “moldable material [of a transfer member] in direct contact with the skin of [an] individual to produce, on the moldable material, the surface profile of the skin,” as recited in independent claim 11. Stess mentions a resin-impregnated, thin, elastic fabric impression shirt 27 (col. 4, lines 12-13), but the impression shirt 27 is not disclosed as being placed in direct contact with skin of an individual. In fact, Stess describes in detail the necessity of a thermal insulation layer and how to prevent direct contact with the impression shirt material. See., e.g., col. 3, lines 29-40, 58-67; col. 4, lines 54-67. Thus, not only does Stess fail to teach placing moldable material in direct contact with skin, as recited in claim 11, but also the reference actually teaches away from any such contact. Moreover, Stess does not disclose producing, on moldable material, the surface profile of skin, as recited in claim 11.

For at least these reasons the Section 102(e) rejection of claim 11 should be reversed.

5. Stess does not disclose scanning with an optical image scanner to obtain scanned image data for an image, as recited claim 11

Similar to claim 4, claim 11 recites “scanning . . . with an optical image scanner to obtain scanned image data for an image.” As discussed above at Section VII.B.2. in connection with claim 4, Stess does not disclose such scanning with an optical image scanner to obtain scanned image data for an image. Thus, the Section 102(e) rejection of claim 11 should be reversed.

C. The Section 103(a) rejection of claims 25-36 and 38-45 should be reversed because the Examiner has failed to set forth a *prima facie* case of obviousness

1. Neither Groh nor Kvedar, nor any combination thereof, discloses or suggests scanning with an optical image scanner to obtain scanned image data for an image, as recited claims 25 and 38

The Section 103(a) rejection of claims 25-36 and 38-45 should be reversed because neither Groh nor Kvedar, nor any combination thereof, discloses or suggests an “image scanner . . . configured in the form of a scanner for scanning documents,” as recited in the independent claims 25 and 38. As discussed above in Section VII.B.2 with respect to independent claim 4, Groh does not disclose an “image scanner . . . configured in the form of a scanner for scanning documents” being used to scan a transfer member. Kvedar lacks any disclosure or suggestion of subject matter remedying that deficiency, and the Examiner has not made any allegation otherwise. Therefore, independent claims 25 and 38 are patentably distinguishable from Groh and Kvedar.

2. There is no motivation, teaching, or suggestion to combine Groh and Kvedar as proposed by the Examiner

The Section 103(a) rejection of claims 25-36 and 38-45 also should be reversed because there is no proper motivation, teaching, or suggestion to combine Groh and Kvedar as proposed by the Examiner. For example, contrary to the allegations in the final Office Action at page 12, one of ordinary skill in the art would not have combined the subject matter of Groh and Kvedar because those references relate to completely different techniques. For example, Groh concerns a method that involves applying an adhesive 12 such as Super Glue to skin, placing a microscopic slide 11 on the adhesive, and then removing the slide 11 after the adhesive sets, to obtain a follicular biopsy sample. Groh at col. 4, lines 1-19. In contrast, Kvedar relates to a method that involves using digital cameras to acquire images. Kvedar at p. 359. In light of these techniques being so different, one of ordinary skill in the art would not have had any reason to combine them.

For at least this additional reason, the Section 103(a) rejection of claims 25-36 and 38-45 should be reversed.

D. Conclusion

For the reasons given above, pending claims 4, 6-8, 11, 25-48, 59, 61, and 62 are patentable over the cited references. The Board is therefore respectfully requested to reverse the outstanding rejections under 35 U.S.C. §§§ 102(b), 102(e), and 103(a).

To the extent any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this Appeal Brief, such extension is hereby respectfully requested. If there are

any fees due which are not enclosed herewith, please charge such fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: April 27, 2007

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VIII. Claims Appendix

4. A process for acquiring scanned image data relating to an external body portion and/or a product applied to the external body portion, the process comprising:
 - placing a transfer member in contact with an external portion of an individual so as to obtain a transfer image on the transfer member,
 - wherein the transfer image is present on the transfer member after the transfer member and the external portion are out of contact with one another,
 - wherein the transfer image is not a fingerprint or fingerprints, and
 - wherein the external portion that the transfer member is placed in contact with does not include a tooth or teeth; and
 - scanning the transfer image with an optical image scanner to obtain scanned image data for an image representative of at least one characteristic of
 - the external body portion, and/or
 - at least one product applied to the external body portion,
 - wherein the transfer member is placed in direct contact with an external body portion including a cosmetic product applied thereto, and wherein the image of the scanned image data is representative of at least one characteristic of the cosmetic product.
6. The process of claim 4, wherein the external portion includes skin and wherein the cosmetic product is foundation makeup.
7. The process of claim 6, wherein the transfer member is formed of fabric.

8. The process of claim 7, wherein the transfer member is an article of clothing.

11. A process for acquiring scanned image data relating to an external body portion and/or a product applied to the external body portion, the process comprising:

placing a transfer member in contact with an external portion of an individual so as to obtain a transfer image on the transfer member,

wherein the transfer image is present on the transfer member after the transfer member and the external portion are out of contact with one another,

wherein the transfer image is not a fingerprint or fingerprints, and

wherein the external portion that the transfer member is placed in contact with does not include a tooth or teeth; and

scanning the transfer image with an optical image scanner to obtain scanned image data for an image representative of at least one characteristic of

the external body portion, and/or

at least one product applied to the external body portion,

wherein the transfer member is a moldable material, and wherein the process includes placing the moldable material in direct contact with the skin of the individual to produce, on the moldable material, the surface profile of the skin.

25. A process for acquiring scanned image data relating to an external body portion and/or a product applied to the external body portion, the process comprising:

 placing a transfer member in contact with an external portion of an individual so as to obtain a transfer image on the transfer member,

 wherein the transfer image is present on the transfer member after the transfer member and the external portion are out of contact with one another,

 wherein the transfer image is not a fingerprint or fingerprints, and

 wherein the external portion that the transfer member is placed in contact with does not include a tooth or teeth; and

 scanning the transfer image with an optical image scanner to obtain scanned image data for an image representative of at least one characteristic of

 the external body portion, and/or

 at least one product applied to the external body portion,

 wherein the image scanner is associated with a first computer located at a first location, and wherein the process further comprises transferring the scanned image data from the first computer to a second computer located at a second location remote from the first location, and

 wherein the image scanner is configured in the form of a scanner for scanning documents.

26. The process of claim 25, wherein the transferring includes transmitting the scanned image data via the Internet.

27. The process of claim 25, further comprising storing the scanned image data on a data storage medium, wherein the transferring includes shipping the data storage medium to the second location.

28. The process of claim 25, further comprising transferring questionnaire answers from the first location to the second location, at least some of the questionnaire answers being related to at least one of a condition of the external portion and the product applied to the external body portion.

29. The process of claim 25, further comprising sending to the second location at least one of billing information and payment information.

30. A process of analyzing at least one characteristic of an external body portion of an individual and/or at least one product applied to the external body portion, the process comprising:

- acquiring scanned image data according to the process of claim 25;
- displaying an image corresponding to the scanned image data; and
- viewing the displayed image to analyze said at least one characteristic.

31. The process of claim 30, wherein the image is displayed at the second location.

32. The process of claim 30, further comprising sending the scanned image data to a plurality of locations so that the at least one characteristic may be analyzed numerous times.

33. The process of claim 30, further comprising monitoring status of the external portion during treatment of the external portion.

34. The process of claim 33, further comprising providing a recommendation for a treatment of the external portion based on the monitored status.

35. The process of claim 33, further comprising providing the individual with information regarding the effectiveness of the treatment.

36. The process of claim 33, wherein the monitoring includes repeating at least the acquiring.

37. A process of analyzing at least one characteristic of an external body portion of an individual and/or at least one product applied to the external body portion, the process comprising:

acquiring scanned image data, wherein the acquiring comprises

placing a transfer member in contact with an external portion of an individual so as to obtain a transfer image on the transfer member,

wherein the transfer image is present on the transfer member after the transfer member and the external portion are out of contact with one another, wherein the transfer image is not a fingerprint or fingerprints, and wherein the external portion that the transfer member is placed in contact with does not include a tooth or teeth, and

scanning the transfer image with an optical image scanner to obtain scanned image data for an image representative of at least one characteristic of the external body portion, and/or at least one product applied to the external body portion;

displaying an image corresponding to the scanned image data; viewing the displayed image to analyze said at least one characteristic; and comparing the displayed image to at least one image formed from image data stored in an image database.

38. A process for recommending treatment for an external body portion, the process comprising:

analyzing at least one characteristic of an external body portion wherein the analyzing comprises

acquiring scanned image data, wherein the acquiring comprises

placing a transfer member in contact with an external portion of an individual so as to obtain a transfer image on the transfer member,

wherein the transfer image is present on the transfer member after the transfer member and the external portion are out of contact with one another,

wherein the transfer image is not a fingerprint or fingerprints, and

wherein the external portion that the transfer member is placed in contact with does not include a tooth or teeth;

scanning the transfer image with an optical image scanner to obtain scanned image data for an image representative of at least one characteristic of

the external body portion, and/or

at least one product applied to the external body portion;

displaying an image corresponding to the scanned image data; and

viewing the displayed image to analyze said at least one characteristic;

determining a recommendation of at least one treatment for the external portion;

and

providing the treatment recommendation so that the external portion of the individual may be treated according to the recommendation,

wherein the image scanner is configured in the form of a scanner for scanning documents.

39. The process of claim 38, wherein the treatment recommendation is a recommendation regarding use of at least one of a cosmetic product and a dermatological product.

40. The process of claim 39, wherein said at least one of the cosmetic product and the dermatological product is one of a makeup product, a care product, a hair product, a skin product, and a sun exposure product.

41. The process of claim 39, wherein the treatment recommendation is a recommendation regarding application of said at least one of the cosmetic product and the dermatological product to the external portion.

42. The process of claim 38, further comprising providing product ordering information along with the treatment recommendation.

43. The process of claim 38, wherein the providing of the treatment recommendation includes providing the treatment recommendation to at least one of the individual and a treatment provider.

44. The process of claim 43, wherein the providing of the treatment recommendation includes transmitting said recommendation to said at least one of the individual and the treatment provider via the Internet.

45. The process of claim 38, wherein a computer at least partially performs the determining of the treatment recommendation, the computer being located at a location remote from that of the image scanner.

46. A process of evaluating a product applied to an external body portion, the process comprising:

analyzing at least one characteristic of a product applied to an external body portion wherein the analyzing comprises

acquiring scanned image data, wherein the acquiring comprises

placing a transfer member in contact with an external portion of an individual so as to obtain a transfer image on the transfer member,

wherein the transfer image is present on the transfer member after the transfer member and the external portion are out of contact with one another,

wherein the transfer image is not a fingerprint or fingerprints, and wherein the external portion that the transfer member is placed in contact with does not include a tooth or teeth, and

scanning the transfer image with an optical image scanner to obtain scanned image data for an image representative of at least one characteristic of

the external body portion, and/or

at least one product applied to the external body portion; displaying an image formed from the scanned image data; and

viewing the displayed image to analyze said at least one characteristic.

47. The process of claim 46, wherein the transfer member is placed in contact with an external body portion including a cosmetic product applied thereto, and wherein the scanned image data is representative of at least one characteristic of the cosmetic product.

48. A process for acquiring scanned image data relating to an external body portion and/or a product applied to the external body portion, the process comprising:

 placing a transfer member in contact with an external portion of an individual so as to obtain a transfer image on the transfer member,

 wherein the transfer image is present on the transfer member after the transfer member and the external portion are out of contact with one another,

 wherein the transfer image is not a fingerprint or fingerprints, and

 wherein the external portion that the transfer member is placed in contact with does not include a tooth or teeth;

 scanning the transfer image with an optical image scanner to obtain scanned image data for an image representative of at least one characteristic of

 the external body portion, and/or

 at least one product applied to the external body portion; and

 collecting information relating to the transfer image of the transfer member to form a database for use in at least one of diagnoses, treatment recommendation determinations, product evaluations, and product formulations,

wherein the image scanner is configured in the form of a scanner for scanning documents.

59. A process for acquiring scanned image data relating to an external body portion and/or a product applied to the external body portion, the process comprising:

 placing a transfer member in contact with an external portion of an individual so as to obtain a transfer image on the transfer member,

 wherein the transfer image is present on the transfer member after the transfer member and the external portion are out of contact with one another,

 wherein the transfer image is not a fingerprint or fingerprints, and

 wherein the external portion that the transfer member is placed in contact with does not include a tooth or teeth;

 scanning the transfer image with an optical image scanner to obtain scanned image data for an image representative of at least one characteristic of

 the external body portion, and/or

 at least one product applied to the external body portion; and

 analyzing at least one of the external body portion and the transfer member with analysis equipment,

 wherein the analysis equipment is chosen from one of a corneometer, a dermal torque meter, a PH meter, and a device for measuring hydration of the skin.

61. The process of claim 48, further comprising providing a grade indicative of at least one of the condition of the external portion and performance of the product.

62. The process of claim 61, further comprising storing information relating to the grade in a database.

IX. Evidence Appendix

None

X. Related Proceedings Appendix

None